

## **REMARKS**

The specification has been amended by moving text from the Background and Summary to the detailed disclosure of the invention to avoid any unintended limitations to the claims. The Summary and Abstract have been amended for consistency with the claims as now presented. Various typographic and similar errors have been corrected. No new matter has been added.

Claims 82, 85-87, 90-101, 104-115 were pending before this response. Applicant respectfully notes that although the Office Action did not list claims 90-101 as pending, these claims were variously rejected in the Office Action.

In light of the complexity of the issues, Applicant has canceled all pending claims, without prejudice, and presented a new series of system claims in order to narrow the issues and move this case to issue. Applicant reserves the right to file one or more continuing applications for further prosecution of the canceled claims and/or additional method and systems claims. Claims 116 – 142 are now pending.

Claims 82, 85, 91, 93, 94, 97, 104 & 112-115 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,248,082) in view of either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as evidenced by Fowler et al (4,744,508). All previously presented claims have been canceled.

In particular, in regard to claim 82, 91, 93, 94, 97, 104 & 112-115, either Bowen et al ('069) or Elmlinger ('082) were held to disclose a multiple layer/ply mailer, where the first and second layers/pplies are glued together in order to form a useable return envelope, a third layer/ply above the second layer/ply contains the bill/message, a fourth layer/ply above the bill/message layer/ply combined with the first layer/ply forms the outgoing envelope, and a fifth layer/ply above the fourth layer/ply that forms a removable cover sheet. Where information printed/applied on/to the cover sheet is selectively vertically transferred to the appropriate locations on the second/third/fourth layers/pplies by using selectively applied image transfer coatings.

The Examiner further held that in the mailers of either Bowen et al ('069) or Elmlinger ('082), the outgoing envelope and the reply envelope are physically attached to one another at the time the outgoing envelope is mailed to the recipient and that as the recipient opens the mailer of either Bowen et al ('069) or Elmlinger ('082), the recipient physically separates both the front cover of the

outgoing envelope and statement sheet/page from the remaining parts of the mailer of either Bowen et al ('069) or Elmlinger ('082).

Applicant notes with appreciation the Examiner's holdings that neither Bowen et al ('069) nor Elmlinger ('082) disclose the use of two layer/plies to form the outgoing mailer and two other/separate layer/plies to form the return envelope.

The Examiner has held that, as taught by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410), a multiple ply or layer mailer may be formed using at least 5 layers or plies, where the first ply/layer forms the back of the outgoing mailer, the top ply forms the front of the outgoing mailer, 2 consecutive plies/layers between the first and top plies/layers form the return envelope, and at least one additional ply/layer between the first and top plies/layers that is an information/statement sheet.

The Examiner has further held, as taught by Fowler et al ('508), that it was known in 1988 that the multiple plies/layers of a mailer may form the various components of a mailer by using one ply of the mailer as part of the outgoing and return envelopes or two plies/layers that are separate from the layers/plies that form the outgoing mailer may be combined to form the return envelope.

The Examiner has further held that since it is known that the various components of a multiple ply/layer mailer may be formed in a number of different manners it would have been obvious to one of ordinary skill at the time of the invention, that the multiple ply/layer mailers of either Bowen et al ('069) or Elmlinger ('082) could be modified to include an additional interior ply/layer that when combined with another exterior ply/layer would form the return envelope as taught by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410).

Applicant respectfully traverses this holding of obviousness, and the series of holdings on which it is based, with regard to the new claims because nothing in these references, singly or combined, teaches, suggests or renders obvious the invention as now claimed in claim 116 in which a continuous feed, multipart, multilayer form with detachable pin feed edges, each part of which includes a top sheet detachable from both pin feed edges, a sealed outgoing envelope detachable from both pin feed edges formed of a second and sixth sheet fastened together on four sides, a third sheet detachable from one pin feed edge, and not attached to the other pin feed edge, and a reply envelope formed from fourth and fifth sheets fastened together on three together with a series of coatings selectively applied thereto so that information impact printed on top sheet produces an

addressed and sealable reply envelope, and a message sheet, removably contained within a sealed and addressed outgoing envelope including a postage permit.

If this rejection is maintained, applicant respectfully requests greater specificity in the rejection regarding the particular and advantageous combination of sheets, areas and coatings in which a tear strip, bottom opening sealed outgoing envelope enclosing a message sheet and a bottom flap, closable reply envelope is produced from a multilayer form by impact printing a top sheet.

Further, in regard to claim 85, the Examiner has held that since one of ordinary skill would not want the mailer of either Bowen et al 0069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) to be destroyed by the postal processing equipment, it would have been inherent to one of ordinary skill at the time the invention was made that each of the layers/plies of either Bowen et al ('069) or Elmlinger ('082) must be made from a material that will survive any reasonably foreseeable potential damage that may be caused during process of delivering the outgoing and return mailing envelopes.

Applicant respectfully traverses this holding of obviousness with regard to the new claims because nothing in these references, singly or combined, teaches, suggests or renders obvious the invention as now claimed in claim 116 in which a sealed outgoing envelope includes a tear strip across its bottom and a closable reply envelope flap across its bottom. If this rejection is maintained, applicant requests greater specificity in the rejection regarding the claimed use of a tear strip and flap positioned transverse to the direction of feed of the outgoing and return envelopes on which they are placed.

Claims 87 & 98-101 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Ehnlinger (5,248,082) as modified by either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as suggested by Fowler et al (4,744,508) as applied to claims 82, 85, 91, 93, 94, 97, 104 & 112-115 and further in view of obvious considerations required by applicant's admitted requirements for processing mail and either Swiercz (EP 0268410) or Tess (4,023,727).

In particular, the Examiner noted that since applicant discloses that the use of FIMs reduces the associated postage costs, it would have been obvious to one of ordinary skill at the time the invention was made that the FIM applied to the outgoing envelope could be also applied to the return envelope using the transfer process of either Bowen et al ('069) or Elmlinger ('082) as modified by

either Van Malderghem ('438) or Juszak et al ('545) or Tess (727) or Swiercz ('410) as suggested by Fowler et al ('508).

Applicant respectfully traverses this holding of obviousness with regard to the new claims because nothing in these references, singly or combined, teaches, suggests or renders obvious the invention as now claimed in claims 117 and 118 a sealed outgoing envelope enclosing a reply envelope in which an FIM is selectively printed on the reply envelope if printed on the top sheet.

Claims 86, 89 & 90, stand rejected under 35 U.S.C. § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,248,082) as modified by either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as suggested by Fowler et al (4,744,508) as applied to claims 82-85, 87, 91, 93, 94, 97-101, 104 & 112-115 and further in view of Fabel (4,461,661) and either Swiercz (EP 0268410) or Leibe (4,770,337). These claims have been canceled.

Claims 92, 95, 96, 105-108, 110 & 111 stand rejected under 35 USC § 103(a) as being unpatentable over either Bowen et al (5,011,069) or Elmlinger (5,248,082) as modified by either Van Malderghem (3,554,438) or Juszak et al (3,905,545) or Tess (4,023,727) or Swiercz (EP 0268410) as suggested by Fowler et al (4,744,508) and as modified by Fabel (4,461,661) and either Swiercz (EP 0268410) or Leibe (4,770,337) as applied to claims 82,85-91, 93, 94, 97-101, 104 & 112-115 and further in view of either Dicker (4,157,759) or Ashby (5,039,000 or 5,163,612) and (In re Japikse, 86 U.S.P.Q. 70 @ 73 (CCPA, 1950)).

In particular, with regard to claims 92, 95, 96, 105-108, 110 & 111, the Examiner has held that since Fabel ('661) explicitly suggests using a tear strip to aid the recipient in opening the mailing, it would have been obvious to one of ordinary skill at the time the invention was made that mailer of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al (\*545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) and as modified by Fabel ('661) and either Swiercz ('410) or Leibe (\*337) could be further modified to include the use of a tear strip that opens from left to right and is positioned along the lower/bottom edge of the mailer as taught by either Dicker ('759) or Ashby ('000 or '612) so that the mailer is suitable for reaching the recipient and accomplishing the purpose of returning the reply of recipient to the original sender.

Further, with regard to claims 105-108, 110 & 111, the Examiner has held that since either Bowen et al ('069) or Elmlinger ('082) or Fabel ('661) or Ashby ('000) use a flap on the return

envelope in order to seal the return envelope, it would have been obvious to one of ordinary skill at the time the invention was made that the flap of either Bowen et al ('069) or Elmlinger ('082) as modified by either Van Malderghem ('438) or Juszak et al ('545) or Tess ('727) or Swiercz ('410) as suggested by Fowler et al ('508) and as modified by Fabel (\*661) and either Swiercz ('410) or Leibe ('337) as modified by either Dicker ('759) or Ashby ('000 or '612).

Applicant respectfully traverses this holding of obviousness with regard to the new claims because nothing in these references, singly or combined, teaches, suggests or renders obvious the invention as now claimed in claim 116 in which a sealed outgoing envelope includes a tear strip across its bottom and a closable reply envelope with a flap across its bottom the combination of which with the other structure of the claim provides a multipart form in which address and other areas are maintained in alignment during printing while presenting a lower risk of damage during later processing. If this rejection is maintained, applicant requests greater specificity in the rejection regarding the claimed use of a tear strip and flap positioned transverse to the direction of feed of the outgoing and return envelopes on which they are placed as well as the interaction between the flap and one of the fastened sides of the outgoing envelope for properly positioning printable areas on the reply envelope as claimed in claim 118.

Claim 109 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over either Smallwood et al (GB 2299036) or McCoy et al (6,409,592) as evidence by Leibe (4,770,337).

The Examiner has held that Smallwood et al ('036) or McCoy et al ('592) disclose a mailer including a sheet of paper having outside and inside surfaces and where information is printed in one or more areas on the outside surface while the area on the inside surface are covered by two different methods. That is, the inside surface is divided into a number of areas, where a security screen is used to cover the inside surface with the exception of the areas that correspond to the areas on the outside surface on which information is printed. And therein the areas that correspond to the areas that have information printed on the outside surface are covered by a dark solid opaque medium in Smallwood et al ('036) or a white solid opaque medium in McCoy et al ('592).

The Examiner has further held that, in the environment of multiple layer/ply mailers, Leibe ('337), discloses that a printed pattern 68 on one side of one or more of the sheets that form the plies/layers of the mailer would provide the function of preventing the contents of the mailer from being scanned by external devices and/or people. .

Applicant respectfully traverses these holdings with regard to the new claims because nothing in these references, singly or combined, teaches, suggests or renders obvious the invention as now claimed in claims 124 through 142 in which block out coatings on the reverse side of the reply envelope front sheet are used to increase contrast on the face of the reply envelope to improve machine readability of data imprinted thereon by other coatings through multiple layers when imprinted by an impact printer on the face of the top sheet.

If this rejection is maintained, applicant respectfully requests greater specificity in the rejection regarding teachings of the art showing the use of block out or opaque areas on the reverse of a sheet to improve the machine readability of data imprinted on the face of the sheet through multiple layers by impact printing on a top layer.

Respectfully Submitted,

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